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IN THE

# Supreme Court of the United States

LA REPUBLIQUE FRANCAISE and LA COMPAGNIE FERMIERE DE L'ETABLISSEMENT THERMAL DE VICHY,

*Appellants,*

*ag'st*

THE SARATOGA VICHY SPRING COMPANY,

*Appellee.*

# Brief on Behalf of Appellee

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Saratoga Springs, New York.

IN THE

# SUPREME COURT

## OF THE UNITED STATES

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La Republique Francaise and La Compagnie Fermiere de L'Etablissement Thermal de Vichy,
*Appellants,*
*against*
The Saratoga Vichy Spring Company,
*Appellee.*

**Brief on Behalf of Appellee No. 53**

This is an appeal by the complainants from a decree of the United States Circuit Court of Appeals for the Second Circuit, which, in the main, affirmed a former decree of the Circuit Court for the Northern District of New York, dismissing the complainants bill.

The matter is brought into this court by a certiorari granted on the 11th day of June, 1902, (page 463), upon a petition therefor, filed by the complainants.

The action was begun on the 27th day of June, 1898, by the issuance of a subpoena (page 79), and the subsequent filing of a bill in the Circuit Court of the United States for the Northern District of New York, (page 1 *et seq.*). In this bill the complainants alleged that the orator, Republic, is an inde-

pendent State and one of the sovereign powers of the earth, having its main territory, and chief seat of authority, in that part of the Continent of Europe known as France, and under French law is denominated the State, having existence, in legal contemplation, immutable and perpetual, nothwithstanding any changes in the form of its government, or of dynasty, or succession; that the orator company, is a corporation organized and existing under the laws of said state, and that the defendant is a corporation organized and existing under the laws of the State of New York, and is an inhabitant of the Northern District, where the bill is filed, (record, p. 1).

After then setting out the facts showing that it is proper that the action be brought in the Circuit Court, it is alleged that in the territory of the orator, the State, in a political subdivision thereof denominated as the Department of Allier, there is a municipality, or town, by the name of Vichy, situate about two hundred and twenty-seven miles south-southeasterly from the city of Paris, which town has been known in civilized countries since the discovery of the locality, in the period of the Roman Empire, and has been clebrated and renowned for the waters obtained from mineral springs situated therein, and thereabouts, which waters for ages have been called by the term Vichy, that the title to the springs was originally in the feudal Lords of the realm, and the various steps are set out by which the orator, the State, became the sole owner thereof, (record, p. 2); that one of the springs mentioned in the bill is not situated in the town of Vichy, but in one of the adjoining districts, and is

called " Hauterive "; that up to the year 1853 these springs were operated by the State, through officers appointed for that purpose, and were then, and are still, protected from trespass, or diversion, by a perimeter of protection embracing a portion of the town of Vichy and some adjoining villages; that under the operation of the State, subject to suitable regulations, the public was afforded access to the springs to drink and bathe, and the water was prepared and sold by bottles in various parts of the world, all of which operations were at that time, and since, in connection with the complainant Company, are, ~~the~~ a source of revenue to the State; that these waters became celebrated throughout the world, including the United States, and that the word Vichy became of great value to the orator, the State, and constitutes, and has long constituted, an important and necessary incident and means to the sale of the water, (record, p. 3).

That in the month of June, 1853, the State leased the exclusive right and privilege of operating the springs at Vichy, for a fixed sum as rental and a chain of title is set out by which such exclusive lease has since, and before the filing of the bill, become vested in the complainant company, and that such lease extends until the year 1934, and comprehends the right to use the word Vichy to designate the waters, (record, p. 4); that since the acquisition of the lease, the orator company has extended the sale of the water throughout the world, including the United States, and since 1854, among other things, has evaporated the water and sold the salts and resultant products, under the name of Vichy salts, and that the waters of the springs have been

sold in large quantities throughout the United States; that the bottle of the complainants has been one of the means by which the waters have been known and identified over the civilized world, where the waters have been sold, and it is described, as is also a characteristic label of the complainants, and the manner of its application to the bottle, (record, pp. 5, 6); that this bottle and label were used in advance of any others, and that the waters have been known and identified both by bottle and label, and that the orators were entitled to be protected in the exclusive use of the designation Vichy, and of the bottle and the label, and from any unfair imitation thereof; that the complainants are entitled to be protected in the exclusive use of the word Vichy as a trade name, and commercial name, by virtue of treaties existing between the Republic of France and the United States, particularly a treaty concluded at Paris on the 20th day of March, 1883 and proclaimed by the President of the United States on the 11th day of June, 1887, in one article of which it is provided that the commercial name shall be protected in all the countries of the Union, without obligation of deposit, whether it forms part, or not, of a trade, or commercial mark, (record, p. 6).

It is then set out in the bill that the defendant, without the consent of the complainants, or either of them, and knowing their rights, was at the time of the verification of the bill, and had for some time, been fraudulently and unlawfully making use of the designation, or trade mark, Vichy, as a name for certain waters taken by the defendant from a natural spring near Saratoga; that the defendant falsely

and fraudulently made use of the word Vichy as a part of its corporate name, and in other ways, in violation of the rights of the complainants, and to their injury, and fraudulently imitated the bottle and label of the complainants, and the bottles and labels are described, the use of such label and bottle being for the purpose of misleading and deceiving the public, and enabling the defendant to sell the water from its spring, as and for the water of the complainants, (record, p. 7); that among other labels used by the defendant is a neck label in which the word Saratoga appears in small type, and the word Vichy in large and conspicuous type; that the use of the word Vichy in the different ways set forth constitutes an infringement of the rights of the complainants, and is inequitable and fraudulent, and constitutes unfair and inequitable competition, and tends to promote the sale of the water from the defendant's spring, as that of the complainants, to the complainants' damage, (record, p. 8); that the good will of the business of selling Vichy water is of great value and that the defendant should be compelled to make disclosure, and account for the profits fraudulently diverted to itself, from the complainants, (record, p. 9).

Judgment is thereupon prayed that process shall issue and the defendant be compelled to answer; that it be enjoined from making use of the word Vichy as a designation of any water taken from its spring, or as a part of its corporate name, or using its labels with the word Vichy thereon, and from doing any act or thing calculated to cause the sale of any water other than that of the complainants, under the name Vichy, (p. 9).

Annexed to the bill are two labels, one, that of the complainants, in the French language, the other, that of the defendant, of course, in English, (pp. 11-13).

The answer of the defendant, among other things, denies that the complainants, or either of them, is entitled to be protected in the exclusive use of the word Vichy as a trade name, or commercial name, or by virtue of any treaty; denies that there has been any fraudulent use of the word Vichy by the defendant, or that there has been any resemblance between the bottle or label of the defendant, and the complainants, or that any persons have ever been deceived by the defendant's bottle, or label, (record, pp. 18, 19).

It is then set out that in the town of Saratoga Springs, Saratoga County, in the State of New York, mineral springs have existed, commonly known by the name Saratoga, from time out of mind; that these waters were first visited by white men in August, 1767, when Sir William Johnson was carried thither by the Mohawk Indians; that the reputation and medicinal properties of these waters early became known throughout the civilized world, and at the time of the formation of Saratoga County in 1791, the waters from the springs at Saratoga had become universally known as Saratoga waters, and Saratoga spring waters, and, from that date down to the present, the name Saratoga, in association with mineral waters, has had the accepted meaning throughout of the world of mineral waters from some of the springs at Saratoga Springs; that from time immemorial a large number and variety of mineral springs have existed

at Saratoga, new springs being continually found, all of which are known as Saratoga waters, and all dependent, for their reputation, upon being waters from Saratoga; that Saratoga has become the world's most famous watering place, and is visited yearly by thousands of people from all parts of the world, and that the waters are shipped, and have become known, throughout the world, so that the word Saratoga has for more than a hundred years been a valuable part of their name, (p. 19); that in the year 1876 (should be 1872, *see* page 40) the spring now owned by the defendant was discovered, and was then given the name of Saratoga Vichy Spring and, thereupon applied for a trade-mark entitling it to the exclusive use of the name Saratoga Vichy Spring Company, and on the 8th day of May, 1877, such trade-mark was duly registered and that, ever since that time, the defendant has had the right to the exclusive use of the name Saratoga Vichy Spring Company, and has ever since made use of it and enjoyed it; that the defendant is incorporated under the laws of the State of New York, under the corporate name Saratoga Vichy Spring Company, for the purpose of bottling and selling mineral waters, such incorporation having taken place July 21, 1876; that, thereupon, in 1876, the defendant immediately entered upon the business of bottling and selling water from this Saratoga Vichy Spring, and has continued to botttle and sell it to the present time as Saratoga Vichy Water, and has acquired a valuable reputation for the water under such name, and at the time of the filing of the answer such names had been used for a period of over twenty-two years without

any objection on the part of the complainants, or any one else, (pp. 19, 20); that for more than fifty years mineral water has been sold throughout civilized countries of the world under the name of Vichy, and that such sale was prior to the business of the defendant, and has been recognized as lawful and permitted to be carried on openly and notoriously, so that the name Vichy has come to denote a type of water, to-wit: an alkaline, non-cathartic, carbonated water, and it does not stand for, nor exclusively denominate, water from any one spring in the world; that even in France it is lawful to sell mineral water, both natural and artificial, under the name Vichy, (p. 20); that the defendant has never sold water as and for the Vichy water of the complainants, nor in resemblance thereto, but that upon all its water there have been labels and marks, so that the purchaser should know that the goods sold by defendant were natural mineral water of Saratoga, and the name Saratoga has always appeared in connection with the name Vichy as designating the water, and has been as prominently displayed as the name Vichy, (p. 20); that the complainant Company, on the 7th of August, 1877, registered in the Patent Office of the United States, as its lawful trade-mark, a picture of a building, claiming exclusive ownership thereof, and that it cannot now be held to say that the Republic has any title or interest therein, (p. 21); that natural mineral water is bottled from springs not owned by the complainatns, in and near Vichy, and imported from France to this country, as Vichy water, to the knowledge of the complainants, and that, therefore, the complainants are not entitled to the sole use of the term

Vichy as applied to mineral waters, (p. 21); that the bottles and labels of the defendant are such that persons purchasing cannot be deceived into the belief that the water sold by one is the product of the other, (pp. 21-22).

It is then alleged that the cause of action set out in the bill did not accrue within twenty years and that it is,therefore,barred by lapse of time,and stale, and the court will not entertain the same, and that there is a misjoinder of parties plaintiff, the complainant Republic having no interest in the matter alleged in the bill of complaint, and that the complainants have an adequate remedy at law.

The allegation of the bill not otherwise met, are fully denied, and judgment is prayed dismissing the bill, (p. 22).

To this answer the complainants served a replication (p. 23), and, thereafter, upon stipulation and order, they were permitted to amend their bill by alleging that they were entitled to the exclusive use of the word Vichy, by reason of the treaty referred to in the original bill, which allegation the defendant denied, (p. 24).

In the record of the evidence taken in this action there is no particular conflict of fact, the facts being practically stipulated (pp. 27-30; 46-50), with the exception of a single purchase of water that was made by a clerk in the office of the counsel for the complainant, which was proved by oral testimony, (pp. 28, 29).

In addition, however, to the tetstimony given in this action and these stipulations, it was further stipulated that the evidence used in the action brought by the same complainants against Louisa

Schultz, executrix, might be offered (and it was offered) in evidence, and used as original evidence, (p. 29).

The record, therefore, contains up to page 102, the proceedings taken strictly in this case, and the remainder of the appeal book, except the writ of certiorari granted by this court (p. 463), is the record made in the Schultz case, which has all the force of evidence given in this case.

The action came on for argument before Judge Coxe sitting as Circuit Judge for the Northern District of New York, and on the 19th day of February, 1900, he handed down an opinion dismissing the bill in all particulars (pp. 103, 104), upon which judgment of dismissal was entered and for costs, (p. 104).

From this judgment thus dismissing the bill the complainants appealed to the Circuit Court of Appeals, for the Second Circuit, filing an assignment of errors, not necessary, perhaps, to specify here.

The appeal was argued at the Circuit Court of Appeals sitting in New York, in January, 1901, and in April of the same year a decision was handed down by a majority of the Court, holding that one neck label used by the defendant from the year 1896, was objectionable for the reason that the word Saratoga was not quite as prominently displayed thereon (i. e. that the letters thereof were not quite as large) as the word Vichy. This label appears on page 35 of the record. And the defendant was enjoined against the use of such label, or any label, in which the place of the origin of the water was not as plainly and prominently made known as the fact

that it was named Vichy. Direction was therefore made that the decree of the Circuit Court be reversed and the case remanded to enter a decree according to instructions, (p. 112).

Judge Wallace dissented from this conclusion of the majority of the court, and held that the decree dismissing the bill should be affirmed, (pp. 113-114).

Upon this decision an order was made that a mandate issue to the Circuit Court, (p. 114). This decree directed an accounting on the part of the defendant. Thereupon the defendant presented to the Circuit Court its petition, in which it set out the various formal steps in the case, and expressed its acquiesence in the decree, except wherein it was directed to account, and calling the attention of the court to the fact that an accounting had never been asked for in the court below, and it prayed a modification of the decree, by striking that provision therefrom, (pp. 114-118).

Upon this petition, which was opposed by the complainants, the decree was amended by striking out the provision for an accounting, and it is from the decree, thus amended, that the complainants have come into this court.

The complainants' testimony is to the effect that the French State, from a time some centuries prior to 1853 down to the present time, has been the owner of certain mineral springs located in the Commune of Vichy, named respectively Grande-Grille, Puits-Carre (or Chomel) Lucas, l'Hospital, the Parc and Celestins, etc. In 1853 the State leased these springs to the present Company, or its predecessors, for a stipulated fixed rental, which lease has con-

tinued down to the present time, and will not expire until the year 1934, (pp. 128-132-140-170), (complaint, pp. 3, 4).

These springs are protected by the State, by what is termed a perimeter of protection, which prevents the owners of ground within certain prescribed territory from making soundings, or other subterranean work, without an authorization of the administration, (p. 127).

There exist, however, other mineral springs at Vichy, not owned by the State, and which are worked commercially by the respective owners, viz: The Lardy, the Larbaud, worked by Compagnie Generale des Eaux Minerales et des Bains de Mer; the Prunelle, belonging to M. N. Larbaud and others. None of these springs have been declared of public interest, but are merely private ventures, upon ground owned by the respective owners of the springs, (pp. 128, 129, 146, 147, 295-297).

There exists also in France, but outside of the Commune Vichy, springs owned, bottled and sold by private individuals as Vichy waters, (pp. 295-297).

The name "Vichy Water" is applied indiscriminately as a generic term to all of the springs of the State, (p. 134).

Under the terms of its lease, the complainant, La Compagnie Fermiere, acquired the exclusive property in, and the use and enjoyment of, such State springs, subject to a fixed, stipulated, rental, (complaint, p. 3), (record, pp, 170-180).

The complainant, La Compagnie Fermiere, bottles and despatches its water, as well into France, as abroad, including the United States, and has done

so since the year 1855, under labels which are its property and not the property of the State, (pp. 139-140).

The complainants' bottle is of dark stained glass, about a foot high and about three and one-fourth inches in diameter at its base. The body of the bottle is about six inches high and tapers in its upper portion to form the neck.

The complainants' label is of white paper printed in black, about five and one-half inches wide, and wholly surrounds the body of the bottle, and is printed in the French language.

This is the only style of bottle and label ever used by the complainant, (p. 30).

Briefly stated this is the Complainants' case.

The defendant showed upon the trial the following facts, under a stipulation entered into by the parties, (pp. 46-50).

For a hundred years and over Saratoga Springs has been world famous as a watering place; there exists at that place numerous mineral springs generally known as waters of Saratoga, or Saratoga waters, but distinguished by individual names, such as Saratoga Congress, Saratoga Hathorn, Saratoga Vichy, etc. The word "Saratoga" in connection with mineral waters has become a generic name, denominating mineral water from Saratoga Springs, N. Y.

The spring of the defendant was discovered in March, 1872, on the farm of one E. A. Duell, in the Town of Saratoga Springs, N. Y. It was found by boring in the rock to the depth of 180 feet. At first, during development, the spring was called "Aetna."

Soon after its discovery the water of the spring

was analyzed by Prof. C. F. Chandler, of the Columbia College School of Mines, of New York City, who found in one U. S. gallon of 231 cubic inches, among other things, Bicarbonate of Soda, 82.873.

The Carbonic Acid Gas in one gallon, was 383.071 cubic inches.

The spring of defendant, when discovered, was a geyser, or spouting spring, throwing its water to a considerable height by the force of its own natural gas; thereafter, in 1873, the name was changed to "Saratoga Vichy Spouting Spring of Saratoga Springs, N. Y." and was extensively advertised throughout the United States.

The complainant has never sold its water in the United States in half pint bottles nor in pint bottles, until the year 1898, or about that time.

The water of the defendant is highly charged with natural carbonic acid gas, and is bottled under a high pressure, to such an amount that, on opening the bottle, the gas is apparent to the most careless person, while the water of the plaintiffs is known as a still water, that is, it has no gas at all, (for these facts *see* Stipulation, pp. 46-50).

On the 7th day of August, 1877, the complainant La Compagnie Fermiere registered in the United States Patent Office a trade-mark, in which it claimed as its own exclusive trade or property, the picture of some building; there was no claim on the part of the complainant, the Republic of France, to any title or interest therein, and no claim was made by anyone to the name "Vichy," (p. 407, and exhibit).

With these pleadings, and on these facts, the Circuit Court wholly dismissed the bill, which having

been, in all essential features, affirmed by the Circuit Court of Appeals, the complainants have come here for review.

The decree should be affirmed and the bill finally dismissed.

## I

The defendant is not shown to have acted in bad faith, nor to have been guilty of any wrong, or unfair dealing; on the contrary, its acts have been characterized by scrupulous good faith during the entire quarter of a century that it did business,prior to the commencement of the action.

1" It has, in all its labels, and advertising, carefully distinguished itself by name, and its water from the water sold by the appellant company. In the record, from beginning to end, the Court will search in vain for any use of the word Vichy, where it is not preceded, and qualified, by the word Saratoga. Beginning with its label set out on page 13 of the record, where the two words are displayed in white letters on a dark background, the letters being exactly of the same size and style, taking the next one (saying nothing now of the neck label which will be discussed later) on page 15, and the others appearing at pages 31, 37, 39, 41, 53, 59, 61, 63, 69, 71, 73 and 75, which are the successive labels and circulars used by the defendant (pp. 27 and 28), each and every one of them uses this word Saratoga in a manner that cannot be overlooked, nor ignored. Not only has the defendant done this from the beginning, and voluntarily, but its every interest has been

to do so, since its fame and reputation and profit have come from the fact that it is a water from Saratoga, and such facts has constituted its chief claim to repute and virtue. Judge Wallace adverts to this in his dissenting opinion in the Circuit Court of Appeals, and it is true beyond question, (p. 113). It stands as literally true, that the defendant has been guilty of no deceit, neither towards the public, nor towards the complainants, but by uniformly proclaiming its water to be from Saratoga Springs, New York, has taken every possible precaution to prevent confusion between the products of the respective parties.

The name Saratoga Vichy makes no claim to being the Vichy imported from France.

Passing now the contention that the word Vichy has become a generic name, he only conclusion deducible from the words Saratoga Vichy, is that the water is from Saratoga, and has certain qualities like the Vichy, and it is certainly neither illegal, nor immoral to claim a likeness to, or superiority to, another article mentioned, but, on the other hand, is the fairest competition.

> Brown Chemical Co. v. Stearns, 37 Federal Rep., 360-362-363.

In reading from Gray's Elegy "Some Village Hampden," no one is deceived to believing that the author actually referred to John Hampden. It was some inhabitant who had, or might have had, qualities of courage and high mindedness like Hampden. The village Demosthenes has never meant other than the most eloquent boy of the place, and has

never confused the most simple, and so this name Saratoga Vichy, means, as stated, a mineral water from Saratoga, having certain characteristics like another water called Vichy.

The final test must be the likeliness of the name, or the package, to deceive the buying public; if not there is no occasion for interference.

Centaur Co. v. Marshall, 97 Fed. Rep., 785-90.

Fisher v. Blank, 138 N. Y., 244-252.

The Court of Appeals of New York very tersely states the proposition in the case last cited: "The "true test, we think, is whether the resemblance is "such that it is calculated to deceive, and does in "fact deceive the ordinary buyer, making his pur-"chases under the ordinary conditions which pre-"vail in the conduct of the particular traffic to "which the controversy relates."

And it is remarkable testimony to the fairness of the defendant that, in all the long years that it has used the name, not a single sale is shown where any purchaser desiring the complainant's water has ever been deceived into buying the defendant's, thinking he was getting his wish. The single sale shown in the record was where the first learned counsel for the complainants, now deceased, in anticipation of, and preparation for, this suit, sent his clerk to Acker, Merrall & Condit for two pint bottles of Vichy. The boy evidently knew what was expected, and did his duty. Saying nothing of the decoy nature of the transaction, which gives no color to the claim that any genuine buyer would be deceived, it is sufficient to say that the order was

for pint bottles, and was given in October, 1898, (pp. 28, 29), and it was not until that year (and possibly later than October) that the complainants ever sold any of its water in the United States, in pint bottles (p. 49), so that the only pints the boy could get were those put out by the defendant. Unless there is evidence of actual deception, relief will not be granted.

Jennings v. Johnson, 37 Fed. Rep, 364-365.

There are two instances where the word Saratoga has not been as large in size as the word Vichy; one a neck label appearing at pages 15, 35 and 73, which went into use in 1896, and a circular appearing at page 39, which had been in use prior to 1896, (p. 28). It was the use of this neck label, that the majority of the learned Circuit Court of Appeals decreed objectionable, and the use of which was forbidden (p. 112), to which direction the defendant has, of course, conformed. While it is not a question before this Court, because as to that label the complainants succeeded, and the defendant has taken no step to review the decision, the attention of the Court is called to the fact that the letters of the word Saratoga are at least three-eighths of an inch in length; that always under this neck label, on the same side of the bottle, appeared the main label, where the word Saratoga is full size with the word Vichy, and it is submitted that no intending purchaser, who could see at all, could fail to see the word Saratoga where it appears the smallest, whether the bottle was in his hand, or on a shelf, across a counter. Indeed, it may well be queried whether the word Saratoga is not the more plainly

visible, from the fact that, at the distances named, the eye can take it in more fully and clearly and quickly than the other word. For a label may be in small print, and still be equally conspicuous with larger.

Cohn v. Hoffman House, 7 Mis. Rep. (N. Y.), 461-462.

But the question is not here.

2" The bottles used by the defendant are not identical with those of the complainants, nor are their packages i. e. the combination of bottle and labels. It is true that every quart bottle must have some resemblance to every other quart bottle, notably in its capacity, but there is no deceiving similarity in those of the conflicting parties. The bottle used by the complainant company is one of dark green stained glass, (p. 5).

The first bottle of the defendant was adopted in 1873, and was of white glass, in the side of which was blown the words "Saratoga Vichy Spouting Spring, Saratoga, N. Y.," surrounding the letter V also blown in the glass. There were three sizes of this, quarts, pints and half pints. They were without label and were used until 1876, (p. 47), while the complainants bottles were always, and only, quarts (p. 30), until 1898.

In connection with this bottle, the defendant issued a circular, which, in itself, shows the entire good faith existing. It appears at page 53. After

giving the name, The Saratoga Vichy Spouting Spring, in prominent letters, and describing the location of the spring, and the manner of taking the water, it says: "This spring contains more soda and 'less salt than any other Saratoga water, and takes 'special rank at once among the valuable mineral "waters of this famous Spa, from its wonderful "similarity to the Vichy waters of France. It is the "only alkaline water found at Saratoga, and a "specific in those troublesome affections arising "from acidity of the stomach, dyspepsia, kidney and 'bladder difficulties; several remarkable cases "already on record of these diseases cured by its "use. This water contains more bicarbonate of 'soda, (82.873 grains) and is more highly impreg-"nated with carbonic acid gas, and more agreeable "to the taste than any other Saratoga Water. The "Saratoga is an excellent table water and superior "to the French Vichy" &c., &c.

A more frank, honest statement could not have been made.

In the year 1876, the defendant became incorporated under the laws of the State of New York, under the corporate name "The Saratoga Vichy Spring Company," the purposes of the corporation being stated to be "the production from the earth, "bottling and sale of mineral waters," (p. 55). It at once became the owner of the spring from which water is still taken, (p. 47).

In the same year the defendant's bottle was changed to amber glass, on the side of which was blown the words "Saratoga Vichy Water, Saratoga, N. Y.," and on the opposite side of the bottle, the letter V. The same three sizes as before were con-

tinued, and this style was used from 1876 to 1879, (pp. 47, 48).

During this period the defendant put out a circular. It is practically the same as the one of 1873, except as to the price list, and appears at page 59, (p. 48).

In the meantime, on the 16th day of March, 1877, the defendant registered its trade mark. It consisted "of a monogram composed of the letters V. S. "and the words The Saratoga, the latter being used "in connection with the words Natural Vichy "Water.....The class of merchandise to which "the trade mark is appropriated is natural mineral "waters, and the particular description of goods "(comprised in said class) upon which said corpo- "ration intends to use its said trade mark is natural "Saratoga Vichy Water." It appears at pages 64, 65 and 66, (p. 48).

From 1879 to 1888 the defendant put out a third circular practically the same as the first and second, displaying the word Saratoga as prominently as the word Vichy, and still calling attention to its superiority to the French Vichy. It appears at page 61, (p. 48).

In 1885 the defendant put out its first labeled bottle. It was of amber glass, with plain sides, with the letter S blown in the bottom. The label was white, printed in black and extended part way around the bottle. It appears at page 31, (p. 48).

A cursory inspection will show that this quart bottle of the defendant is shorter than the bottle of complainants, is a trifle larger in body and neck, and is amber in color, while the complainants' is dark green. The label extends but half way around

the bottle, with little printing, the most prominent words being "Saratoga Vichy Water," and is all in the English language. The complainants' label is in the French language, extends entirely around the bottle and has a large amount of printed matter covering it. These were used until 1887, (p. 48).

In 1888 a change was made in the label on these bottles, by which it was extended entirely around the bottle. With that exception, it was similar to the label of 1885, and contained all its dissimilarities to the bottle of the complainants. It appears at pages 13 and 67, and was used until 1896, (p. 48).

From 1888 to 1896 two other circulars were issued by the defendant, with all the characteristics of the prior ones. They appear at pages 69 and 71, (pp. 48, 49).

In 1896 the defendant again changed the style of its quart and pint bottle to a bottle of green glass, generally recognized as the Appollinaris bottle. This was without imprint of any kind. The quart is shorter than complainants' bottle, and is of light green glass, while that of the complainant is dark green, (*See* deft's. exhibit, fifth bottle, p. 49).

This style of bottle has been used continuously from the time of its adoption to the present time, and is the present style of bottle used by it, (p. 49).

In the same year the defendant adopted, in connection with this bottle, a body and neck label, the body label being oval shaped, and extenging about half way around the bottle. It was of white paper and printed in red and black characters. The neck label is of white paper, about four and one-half inches long, by about one and one-quarter inches

wide, with the name Saratoga Vichy printed in red and black letter. This label appears at page 73, (p. 49). This was the defendant's style of label until the order of the Circuit Court of Appeals, and any similarity to complainant's label will hardly be claimed.

3" The dissimilarity between the packages of the complainant and those of the defendant is further shown by the fact that the water of the complainants is still, without carbonic acid gas, while that of the defendant is highly, naturally, charged with it, and is bottled under a high pressure of such gas, so much so that on opening a bottle the gas is apparent to the most careless person.

All of which is stipulated by the complainants, (p. 50).

4" The defendant in adopting the word Vichy, in connection with its water, did not intend to defraud the complainants, nor to deceive the public; it has never sold its water as, or for, the Vichy water of the complainants, nor in resemblance thereto, but all its water has been, in proper manner, labeled and marked, so that the purchaser shall know that

the goods sold by the defendant is a natural mineral water of Saratoga, and not the water of the complainants. This testimony is without the slightest contradiction, in word or in deduction, and evidence of such intent was competent.

Pope v. Hart, 35 Barb. (N. Y.), 630-636-637.
Cortland v. Herkimer, 44 N. Y., 22-26.
Bayliss v. Cockroft, 81 N. Y., 363-371.
Davis v. Marvine, 160 N. Y., 269-276.
Lally v. Emery, 54 Hun (N. Y.), 517-520-521-522.

Moreover, upon all the defendant's bottles, brands, price lists and advertising matter, the name Saratoga, and other words designating the location of its spring and water, as of Saratoga, N. Y., has appeared in connection with the name Vichy, and the name Saratoga, has been as prominently displayed as the name Vichy, (pp. 49, 50).

In view of these facts the concluding sentence of Judge Coxe's opinion, in dismissing the bill, seems entirely appropriate: " An individual stupid enough ' to be deceived in such circumstances is beyond the " aid of a Court of Equity. In his case a writ *de* " *lunatico* is a more appropriate remedy than a writ " of injunction," (p. 80).

We may, therefore, approach the subsequent steps of the argument, in full reliance upon the fact of the good faith of the defendant, in all its acts here complained of, and the conclusion to be reached on this appeal, msut be reached with such full, good faith in mind.

## II

The name "Vichy," in this country, has come to be a generic name, meaning an alkaline, carbonated water. The manufacture and sale of water under the name "Vichy" began as far back as 1863, and the business soon grew to such enormous proportions that it became, and is now, a matter of common knowledge, and all this, without protest of any kind from the complainant company, which had established agencies in this country.

Even in France the name Vichy is applied indiscriminately, as a generic term, to each of the springs at Vichy, those not owned by the Republic, and not leased by the complainant company, as well as those that are, (p. 134). And the generic character of the word "Vichy," and the right to bottle and sell mineral water under that name by proprietors of springs situated in France, but outside of Vichy, has been adjudged in the French courts, in a case decided in January, 1888, in a suit by the complainant herein "Compagnie Fermiere" etc., against another corporation, called Compagnie Proprietaire des eaux Minerales de Vichy. The judgment restrains unfair competition but specifically authorizes the use by the defendant of the terms "Water of Vichy" and "Natural Mineral Waters of Vichy" (pp. 440-452).

Browne on Trademarks (2" edition), Sec. 757, mentions this judgment of the French Court.

Aside from this adjudication, the testimony to this effect is overwhelming and conclusive.

The manufacture of artificial mineral water was first introduced in Germany by Struve in 1823 (pp. 264-266) Hermann Endemann, chemist, has been connected with several establishments for the manufacture of Vichy water (p. 268), and in 1888, was commissioned to make examination of the artificial Vichy waters as they were sold in New York (p. 264). The witness' personal knowledge of the manufacture of Vichy in this country goes back as far as 1867, when it was made by Carl H. Schultz, Dr. Hanbury Smith and John Matthews (p. 268). The witness knows of a dozen manufacturers of Vichy in New York City alone (p. 280). It was all labeled and sold as Vichy, in syphons and from soda fountains (p. 268). As far back as 1869 a person calling for Vichy water expected to get a very alkaline water, fit for neutralizing the acidity of the stomach (pp. 268-269). The witness further testified that Vichy water, other than the French, has been manufactured and sold continuously from 1867, down to the present time, and that it is used in New York and throughout the United States to a very considerable degree. It is not only kept in drug stores, but it is kept as a regular drink in nearly all bar rooms (p. 268).

The witness further testified that he is acquainted with natural mineral waters which employ the name Vichy in this country. He says: "Among the 'Saratoga Springs of the State of New York, the 'most alkaline water, that is, the water which con-'tains the largest amount of bicarbonate of soda, 'has on account of this fact been called Saratoga 'Vichy, in accordance with the ordinary under-

'standing that Vichy water means a very alkaline 'water."

This water, he says, has been bottled and sold in the market since 1871 or 1872 (pp. 269-270). The Reignier and Hauterieve Globe Springs are commonly known in the American market as Vichy water, and are so labeled (p. 272).

The various manufactured Vichy waters are all different, some like the French, and others away off (p. 281). The various French waters also differ widely in analysis (pp. 281, 411).

Bouche, Fils & Company of New York City, as agents of the complainant, have imported from the same concern in France, and sold in this country since 1880, not only the water of the complainant's but also the Reignier and Hauterieve, from private springs in France, but located outside of Vichy; such water being known as, and labeled, "Vichy" (pp. 295-297).

The witness, Dr. Augustus Caille, says that artificial Vichy has been sold in this country from his earliest recollection; that it was sold in New York City while he was there from 1868 to 1872, and that he made Vichy for his father in Iowa in 1873, and it was sold there as "Vichy," and was not called artificial (p. 309). He knew of a number of druggists who made their own Vichy at that time, and sold it as Vichy (p. 301). The word Vichy is generally understood to mean an artificial water (p. 301). In prescribing Vichy for patients he always uses the term, imported Vichy, when prescribing any of the Vichys from France (p. 302). As to the extent of the sale in the United States of Vichy waters other than that of the complain-

ants, he says that he has drunk it in most all parts of the country where he has been, south and west, and in Canada, and in Germany and Switzerland (p. 303). The witness knows of no other name than Vichy by which these waters could be called, to properly designate them (p. 303).

The witness, Charles A. Kinch, physician, testifies to the same effect, and that he has known and prescribed artificial Vichy since 1879 (pp. 303-305). He prescribed Vichy for its alkaline and carbonic effect, and in prescribing the French water, he terms it imported, and often names the spring (pp. 307-308).

Max Einhorn, physician, says the word "Vichy," as understood by the public, means the artificial Vichy sold by druggists. He has found it where he has traveled in the White Mountains, Washington, Baltimore, Philadelphia and Saratoga. In prescribing the French water, he uses the term imported (pp. 310-311). He says that among the lay-public by Vichy is simply meant a mineral water. He prescribed Vichy for its alkaline properties (p. 311).

Samuel J. Mettzer, physician, testifies to the same effect. Has known of the artificial Vichys as long as he has been practicing, fourteen years (p. 314). The usual understanding of his patients, when speaking of Vichy, is that it is some sort of mineral water (p. 315).

G. Langmann, physician, says that he has known artificial Vichy waters here for twenty-eight years (p. 316). Has prescribed the use of Vichy for his patients, and always supposed they got the artificial (p. 316-317). The witness says in answer to the

question could the name Vichy be expressed in any other way, not using the name Vichy, so as to convey the same meaning to the public. Answer—"I 'don't know if it could, because it has become a 'substantive that denotes a certain quality of exis-'tence as I might say a horse denotes a horse, 'and 'Vichy' denotes an alkaline water," (p. 320).

John P. Durfee, Jr., was manager for John Matthews of New York, manufacturer of soda fountains from 1832 to 1891 (p. 321). During the past seventeen years to his personal knowledge, and before, the concern manufactured, among others, Vichy water and sold it to the public and to druggists simply by the name "Vichy." The sale of Vichy water is large; the public demanded it in drug stores as Vichy (p. 322). It is sold throughout the United States. He says that when you call for Vichy you expect to get the artificial, because it is almost universal here to expect to receive artificial water, unless you call for natural water specifically, specifying the natural water. The same is true wherever the water is dispensed. It is the common custom of the people (p. 323-324). He says that there have been other manufacturers of Vichy in the city for many years, and that his firm never received any complaint from the Republic of France, or the Vichy Company (p. 324). The witness knew of no drug stores in New York where artificial Vichy was sold by any other name than simply "Vichy" (p. 326).

Martin Heldt, Jr., druggist, says he has known of the manufacture and sale of artificial Vichy water in this country for over twenty years (p. 329). People calling for the French Vichy, ask for

the imported (p. 329). No one ever asks for 'artificial Vichy," just "Vichy" (p. 331).

Charles Light, manufacturer of mineral waters for twenty-eight years, and Vichy for eighteen years, (p. 333) sells to drug stores, liquor stores, saloons and private. Syphons or bottles are marked just "Vichy" (p. 333). Never received any protest by the Vichy Company, or the French Republic, against selling artificial water under the name Vichy (p. 333).

George Gregorius, druggist in New York City for thirty-four years, has known of the manufacture of Vichy water since 1864, and has sold it all the time since then, under the name "Vichy" (p. 336).

Max Wustrow, pharmacist, has known manufactured Vichy for twenty-five years. It has alway· been sold to the public under the name Vichy. Witness has sold the Vichy of various manufacturers. People simply call for Vichy; when they want the imported, they ask for "imported," and then I inquire which spring, the Grande Grille, or Celestin, asking them to specify (p. 388). If a customer asked for "Vichy" I would understand that he wanted an alkaline water (p. 329).

John E. Ludin, manager for the New York Bottling Company for twenty-one years. Have manufactured Vichy water for twenty-one years. It has always been sold to the public by the name "Vichy," and the druggists sell it in the same way. Never been any protest from the Vichy Company, or the French Republic, against such manufacture or sale (pp. 339-340). The people ask for Vichy, and we sell them the artificial. The name Vichy was

given to the water for the reason, in the first place, that the practice has been followed by the trade since a good many years, since as far as I can recollect, probably thirty-five years. It is a carbonated, alkaline water (p. 341). The witness further says: Now there is no such thing as a Vichy water, any more than you would say there is a Saratoga water. If you go to Saratoga there are probably a dozen different springs, and any of them are Saratoga water. There are five prominent springs in Vichy which doctors recommend. The Grande Grille, Celestins and Elizabeth, the doctors recommend for drinking purposes, and the others are generally used for bathing purposes, and when we get special orders from certain customers for Vichy Water, imported, they generally give the name of the Vichy. Then they specify, and it is generally at the recommendation of a doctor. Now Vichy does not mean anything; it is a very vague name. Vichy is the name of a locality in France, in which there are various springs (pp. 340-341). The natural water is always specified and called for, either by specific name, or pointing out what is demanded (p. 342) He says also that there must be at least two hundred manufacturers of mineral water in New York City who make artificial Vichy, but he does not believe there are more than three who imitate any spring. The others make a water, principally bi-carbonate of soda, carbonated so as to be sparkling (p. 342). We imitate the Grande Grille and could call it that, but do not, simply call it Vichy, for an alkaline water (p. 343). Witness knows of the manufacture of artificial mineral waters by Dr. Struve in Europe. Was in his establishment in

Dresden, Frankfort and Berlin (p. 345). Struve is considered the father of the mineral water industry in Europe. He commenced in 1840 (p. 346). Witness also visited every mineral water establishment in Berlin, Hamburg, Dresden, Bremen, Frankfort, Lyons, Paris and London. In London they manufacture mineral waters and put them up in bottles, and the same way in Germany, with a label to indicate which spring is imitated. I consider that we have done more to build up the reputation of Vichy than anything they have done. They never advertised the water as extensively as we have advertised it (p. 347).

George Kleinan, druggist, has known of the manufacture and sale of Vichy for fifteen years, and sells it under the name Vichy. They generally call for Vichy, and we give them the artificial. It is the custom of other druggists I believe. I sell it also from a soda fountain. I also sell the imported Vichy. It is demanded as "Imported Vichy," and the name of the spring is given (p. 348).

Peter Rankin, manager for Carl H. Schulz since 1867, manufacturer of mineral waters, twenty-two years in all, including Vichy, (pp. 349-350) of which the output of Vichy alone is about a million syphons a year (p. 350). It is ordered as Vichy, and as Vichy it is commonly spoken of and demanded by the public, and prescribed by physicians (p. 351). The concern has over 700 physicians who drink it in their own families. The word Vichy as applied to a mineral water is supposed to be water charged with gas, containing somewhat an excess of soda (p. 354).

Henry S. Webster, druggist, says that the word Vichy as applied to an artificial water is more common than the word Seltzer applied to another artificial water, and there is more Vichy drank (p. 357).

William E. Crane, druggist for thirty years, and during that time has known of manufactured Vichy and it is commonly known by the name Vichy and demanded and sold as such (p. 359) The imported Vichy is always specified as imported, when demanded by the public. Witness has never heard it asked for in any other way than imported Vichy. The witness further says that there are but two natural Vichy waters that he ever saw That he has known Saratoga Vichy between five and ten years, and that it is always demanded as "Saratoga Vichy" (p. 361). The word Vichy is more common than the name Seltzer, and is asked for oftener (p. 361).

Henry Schmidt, pharmacist and physician. Has known of the manufacture of artificial Vichy for twenty-six years. It was always labeled and known as Vichy (p. 361). Never in twenty-three years did any customer complain of receiving artificial Vichy, when calling for Vichy (p. 362).

Joseph Weber, pharmacist, for the past thirty-five or forty years, and has sold artificial Vichy ever since he was in business in New York for himself since 1867. The imported Vichy is always demanded as "Imported Vichy." "A bottle of imported Vichy." Unless a customer demands specifically the imported Vichy I would assume that he wants the artificial, and that has been the common practice all these years (p. 364).

Peter Haykendorf, druggist since 1864. Has

known of artificial Vichy as long as he has been in the drug business. It was always recognized as a legitimate business to manufacture and sell it (p. 365). It was simply sold under the name of Vichy. From 1864 to 1872 I was in the drug business in Denmark, and artificial Vichy was sold there (p. 365). Has sold the Vichy waters of various establishments (p. 366). Also sells the imported, which is asked for as the imported generally. The word Vichy has become a general term for a carbonated, alkaline water, as Seltzer means an artificial water, slightly salted (p. 367).

Thomas Latham, druggist about twenty-eight years. Has known of the manufacture and sale of Vichy since 1870. Sell it myself as Vichy. Sell the imported Vichy also. It is usually prescribed by physicians as imported Vichy, giving the name of the particular spring that is desired (p. 368).

Charles L. Finch, druggist, in business thirty-five years and for myself eighteen years (p. 369). Have been acquainted with the sale of artificial Vichy for twenty-eight years and have sold it myself (p. 370). I also sell the imported Vichy. Customers who want the imported Vichy always specify it as imported, or in some other way different from the ordinary syphon, or bottled Vichy, as asking for the special spring (p. 370). Any druggist having a fountain can make an artificial Vichy himself. I know it is done (p. 371). The fountains are labeled simply "Vichy" (p. 372).

Henry A. Cassebeer, apothecary since 1860, has known artificial Vichy ever since that time. Has sold it and still sells it. Nearly every mineral water manufacturer makes it. My father first made some

in 1860, (pp. 372-373). In 1861, syphons and a formula written in French were sent over from Paris, and the man who had them sent over wanted my father to go into business with him. Shortly after that, Schultz and Walker started their factory for making artificial waters in syphons, and ever since that date the trade has increased, and increased in size, (p. 373). When a man comes and asks for natural Vichy I always ask him what kind. I believe there are four or five different sources, (p. 374). The proportion of Vichy sold is about-one-half of one per cent. of natural, to ninety-nine and one-half per cent. of artificial, (p. 375). The name "Vichy" in the United States, as applied to mineral water, means an alkaline, aerated water, or carbonated water, (p. 375). In selling artificial Vichy, I take no account of the spring imitated, just deal in it indescriminately as Vichy, but with the natural mineral water it is different, (p. 377). Vichy is more or less of a generic name in the trade. When they call for a Vichy water they mean an alkaline water, charged with carbonic acid gas. The people like to drink a water that is bubbly, that is a little alkaline and that contains carbonic acid. The name Vichy was adopted because the Vichy spring contains an alkali, and the people need some kind of corrective for their stomachs, (p. 378). I don't think the manufacturers appropriated the name Vichy for the purpose of giving to the artificial water the reputation of Vichy water, because they had no reputation here in America at that time. There was no reputation to take in America, (p. 379). I don't think the first manufacturer ever knew where the Vichy spring was, but Mr. Schultz

was an intelligent man and he knew and might have done that, (p. 379).

Henry J. Smith, bar-keeper at the Astor House. Has been a bar-keeper for thirty-five years, ten years at the Astor House, ten years at the St. James and five years at the Metropolitan Hotel on Broadway, New York, (p. 380). Has sold syphon Vichy since about 1863 or 1864, during the latter part of the war, when it first came out. Sold it over the bar right along ever since. If persons want French Vichy they ask for it; but one who drinks syphon Vichy, an ordinary drink of Vichy; if I were to give them French Vichy they would not take it, they would call it dead; it is still, it is not charged, (p. 381). We don't sell a dozen bottles of French Vichy a year, but of Syphon Vichy, seltzer and carbonic water I use a hundred a day, may be. A great many mixed drinks are made with seltzer or Vichy. You cannot use French Vichy,or German Seltzer,for that because there is no gas in the water, (p. 382). When persons demand the imported Vichy at the bar, they always ask for the imported, or French, Vichy. That has always been the case since 1864 or 1865, (p. 382).

Emil Roho, steward New York Riding Club for five years and before that, cook at Delmonico's and other places. Has sold the artificial Vichy. It is demanded as just 'Vichy," (p. 384).

Otto Brandt, manufacturer of mineral spring waters since 1867, in Newark. Has manufactured artificial Vichy since 1867 and sold it in syphons labeled "Vichy Water," or only "Vichy" and my name and address. That is the usual practice of manufacturers of Vichy water in this country,

and, it is sold in that way to the public, (p. 385). When I commenced to manufacture, I did not know we had imported Vichy in the market. Did not know it until some three years ago, (p. 386).

William Schmidt, bartender, Stevens house. Has sold mineral water for forty years. Has known Vichy water ever since he has been in business. Don't recollect ever seeing imported Vichy, (pp. 388-389).

Dr. Enno Sander of St. Louis, Mo., manufacturing chemist for over forty years, during all of which time he has manufactrued Vichy water in the City of St. Louis, and sold it in syphons and bottles, (p. 402). My Vichy was put on the market as my product,highly carbonated,in half pint and pint bottles, distinguished by my label from any other Vichy. My knowledge of the manufacture of Vichy in European countries has been obtained mainly from the publications of Struve and Soltman, who conducted large plants for the manufacture of artificial mineral waters all over Germany, Russia and England, over fifty years ago and produced Vichy for sale ,(p. 403). The word "Vichy" in this country means simply an alkaline water, (p. 404).

The foregoing testimony is followed by extracts from numerous publications all proving the widely disseminated manufacture of Vichy water throughout this and European countries, and the generic meaning of the name "Vichy."

In view of this testimony and the common understanding that this Court itself must have on the subject, it is submitted that the word "Vichy" has become, and is, a generic name, signifying an alkaline, carbonated water.

Websters International Dictionary, under name Vichy water, points the some result: "A mineral "water found at Vichy, France.

"Also by extension any artificial or natural water "resembling in composition the Vichy water "proper, called also, colloquially Vichy."

Dunglison's Medical Dictionary (1874) defines Vichy water as made of simple, acidulous water, impregnated with twice its bulk of carbonic acid gas.

The word Vichy having thus become a generic name, with the significance stated, the complainants cannot be heard to claim that they have any trade-mark, or trade name, therein, or any right to legal protection in the exclusive use of it, for a generic name, one merely descriptive of an article, of its qualities, ingredients, or characteristics, cannot be employed as a trade-mark.

Canal Co. v. Clark, 13 Wallace, 311-323.

Judge Brown states the rule thus in Burton v. Stratton, 12 Fed. Rep. 696-701-3: "The only satisfactory rule we have been able to gather from the "authorities is that, in each case, it is a matter for "the court to determine, not alone from the mark "itself, but from the testimony, whether the words "have become so well known as to stand in the public eye as denoting the character and quality of "the article, and not its origin, or ownership. Thus, "if it should appear that the article had been manufactured and sold by a number of dealers under a "particular name, this would be decisive that the "plaintiff had no right to the exclusive use of that "name. Most, if not all, of these generic names

"were at first indicative of the origin, but finally, "by constant use, ceased to subserve that purpose "and have become indicative of the quality. An "example of this is 'Fowler's Solution of Arsenic' "which clearly indicates origin, but the article is "nevertheless put up by druggists all over the coun- "try, and this name has become public property. "We think that most, if not all, the cases upon this "subject, when carefully examined, will be found "to have turned upon the extent to which the name "is used, rather than upon the name itself."

In Hostetter v. Fries, 17 Fed. Rep., 620-2, Judge Wallace says that a name alone is not a trade-mark when it is understood to signify, not the particular manufacture of a certain proprietor, but the kind or description of the thing which is manufactured.

To the same effect are

Air Brush Mfg. Co. v. Thayer, 84 Fed. Rep., 640-1.

Brown Chemical Co. v. Sterns, 37 Fed. Rep., 360-1.

Clotworthy v. Schepp, 42 Fed. Rep., 62-3.

Columbia Mill Co. v. Alcorn, 150 U. S., 460-3 *et seq.*

Corbin v. Gould, 133 U. S., 308-314.

Sterling Remedy Co., v. Gorey, 110 Fed. Rep., 372-3.

Vitascope Co. v. U. S. Phonograph Co., 83 Fed. Rep., 30-1-2.

N. Y. Asbestos Mfg. Co. v. Ambler Asbestos &c., 99 Fed. Rep., 85.

*See* too the latest utterance of the Court of Appeals (N. Y.) on the subject, decided in October, 1903.

Barrett Chemical Co. v. Stern, 176 N. Y., 27-30.

## III

The complainants were guilty of laches in seeking a vindication of their rights, and the decree of dismissal should be affirmed for that reason.

The subpoena was issued on the 27" day of June, 1898, and was served presently thereafter, (p. 103).

The defendant's spring was discovered in March, 1872, (p. 46). The word Vichy was applied to it in 1873, in the title " Saratoga Vichy Spouting Spring of Saratoga Springs, N. Y.," and it was extensively advertised throughout the United States, (p. 47). On the 21" day of July, 1876, the defendant was incorporated as " The Saratoga Vichy Spring Company," (p. 47 and 55).

March 16, 1877, the defendant registered its trade mark (p. 48), repeatedly using the word Vichy in its statement, (pp. 61, 62 and 63). On every bottle, label and circular issued since 1873, has been prominently displayed this word Vichy, (in connection with the word Saratoga). So that, when the bill was filed in June, 1898, the defendant had been openly, with the widest publicity, using the offensive designation, a few weeks more than a quarter of century.

It was not done in a corner. Secrecy would have defeated success in the defendant's business. Publicity was essential, and the utmost effort was put forth to obtain it. Not only were bottle and label and circular widely distributed, but the name was

recorded in the office of the Secretary of State at Albany, and filed with the proper office in Washington, open to all the world, and such recording and filing were solemn evidences of the intention of the defendant to build up its business around this name. Under these circumstances, the Courts, for laches a very much less time than here shown, have repeatedly denied relief. Recovery, either of damages, or the obtaining of injunctive relief, in such case, would violate the principle of every statute of limitation, or repose, which every civilized state deems an essential part of its jurisprudence.

The most patent reason for refusing relief under such circumstances, is that the complainant has stood by, and permitted the defendant to build up a business, and establish a good will that has become valuable, so that the granting of present relief would wreck, and absorb to the complainants, a business, which it has permitted to become valuable, without complaint, and this is intolerable. If the complainants, here have allowed the defendant to build up a profitable business, on every fair principle, it should be estopped from wrecking it.

To allow them to do so would give them a dishonest, and unconscientious, advantage, as the fruits of their own wrong and negligence, and the rule has always been that improper delay in applying for relief, or laches in the enforcement of his rights, causes a party to forfeit his rights to relief by injunction.

And so in Amoskeag Manufacturing Co. v. Garner, 55 Barb (N. Y.), 151, where it was sought to

restrain the use of the word Amoskeag, relief by way of injunction was denied because of a delay of nine years.

In Leggett v. Standard Oil Co., 149 U. S., 287-294, which was an equitable action, this Court held that a delay of fourteen, or fifteen, years showed such laches as would clearly preclude any right to relief, citing, among other cases, McLean v. Fleming, 96 U. S., 245.

In Sullivan v. P. & K. R. R. Co., 94 U. S., 806-11-12, this court quotes from Smith v. Clay, Ambler, 645, the following language: "A court of equity "which is never active in giving relief against con- "science, or public convenience, has always refused "its aid to stale demands, where a party has slept "upon his rights, and acquiesced for a great length "of time. Nothing can call forth this court into "activity but conscience, good faith and reasonable "diligence. Where these are wanting, the court is "passive and does nothing. Laches and neglect "are always discountenanced; and, therefore, "from the beginning of its jurisdiction, there was "always a limitation to suits in this court."

The delay in the case cited was seven years.

In McKnight v. Taylor, I How., 161-167-168, Chief Justice Taney writing, this court reached the same result, in a case of a delay of nineteen years.

In Godden v. Kimmell, 99 U. S., 201-210-211- 212, Justice Clifford, writing for the court, says that eqiuty courts, in cases of concurrent jurisdiction, usually consider themselves bound by the statute of limitations which governs courts of law in like cases, and in many other cases act upon the analogy

of the statutory limitations at law, and that support to these propositions is found everywhere; that courts of equity in such cases often act upon their own inherent doctrine of discouraging, for the peace of society, antiquated demands, by refusing to interfere, where there has been gross laches in prosecuting the claim, or any acquiesence in the assertion of adverse rights.

In Brown v. Beuna Vista, 95 U. S., 157-161, Justice Swayne says, that laches and neglect are invariably discountenanced in equity, and, therefore, there has always been a limitation of suits in such courts, from the beginning of their jurisdiction, and that limitations of the kind are dictated by experience, and are founded upon a salutary policy, as the lapse of time carries with it the memory and life of witnesses, the muniments of evidence, and the other means of judicial proof.

In Lewis v. Chapman, 3 Beav., 133, the Master of the Rolls refused an injunction to restrain the infringement of a copyright, solely on the ground of a delay of six and one-half years.

In Landsdale v. Smith, 106 U. S., 391-2, a delay of forty-five years was held fatal on demurrer.

And this court in the Saxlehner case, 179 U. S., 19-35, reaffirmed the doctrine that a party, seeking to enjoin the use of the name Hunyadi was bound to use reasonable promptness.

In McLaughlin v. Peoples Ry. Co., 21 Fed. Rep., 574, Justice Brewer held that a delay of thirteen years in instituting a bill for the infringement of a patent, made the bill bad on demurrer.

The complainants have much exploited upon their brief filed here, the case of McLean v. Fleming,

96 U. S., 245, where in a case where there had been long delay, this court upheld a decree of the Circuit Court for the District of Missouri, enjoining an infringement of a trade-mark while denying an accounting. The case is an extreme one, and if not opposed by the great bulk of the decisions of this court on the subject, it certainly goes further.

Although the delay had been about twenty years (p 254-5), the court found that the defendant had deliberately intended to infringe the rights of the complainant — a finding that cannot be reached here.

In McIntyre v. Pryor, 173 U. S., 38, the court recognizes the difference between cases where actual fraud exists, as in the McLean case, and where it is lacking, as here. Where fraud does exist the principle of laches has but an imperfect application, and delay, even greater than that permitted by the statute of limitations, is not fatal to plaintiff's claim.

We have only to refer to the cases analyzed in that opinion for this distinguishing principle that, where actual fraud is proven, the court will look with much indulgence upon the circumstances tending to excuse the plaintiff from a prompt assertion of his rights. Indeed in cases of active and continuing fraud, they are satisfied with no evidence of laches that does not amount to proof of assent, or acquiescence.

As actual fraud existed in the McLean case, and as there is no ground for claim that it exists here, the distinction between that case, and the one at bar, is clear and striking, and decisive.

There is this further distinction between the case at bar, and this case of McLean, in that in the McLean case there was nothing set up in the answer, charging the complainants with laches (96 U. S., 256), while here the defense is distinctly pleaded, (p 22).

Under such circumstances and with such distinctions existing, the McLean case will not be regarded as controlling here.

## IV

But the complainants seek to escape from this rule, which most effectually meets their demand for relief, by the claim that because the French Republic, one of the world's sovereign powers, is a ccomplainant here, there is no prescription, and that laches cannot be predicated upon any lapse of time. The claim is based upon the well understood doctrine that the governing power, whether People, or States, or King, or whoever it may be, is so engaged in the public business, in the affairs of State, that it is against public policy that laches should be imputed to a sovereign complainant.

The principle has no application here.

1" However much courts will hold themselves bound to hear complaints of their own sovereign power, for the reasons stated, there is nothing requiring, or making it obligatory to comity, that they should so hold with respect to foreign powers. It is a matter of no concern to our courts, to indulge in the fiction that the government of France since 1873 has been so busily engaged in the public business of the French people, that it could not attend to the vindication of its private rights.

When a foreign government comes into our courts, it stands, and must stand, on the precise plane of a private litigant. No public policy demands anything different, and a holding as asked by the appellants would be well nigh intolerable. The reason of the rule is that the subject must yield his convenience, and, if necessary, his rights, for the common good in the maintenance of the government that affords him security and protection. But there is no reason why he must thus yield, either his rights, or his convenience, for the benefit of a government that does not afford him protection, and to which he swears no allegiance, and the reason ceasing, the rule must cease.

2" But, passing any reasoning on the subject, the treaty between the French Republic and the United States, requires the same result.

The amendment to the bill of the complainants

alleges that, by virtue of the treaty between the United States and the government of France, concluded at Paris on the 20th of March, 1883, and proclaimed by the President of the United States on the 11th day of June, 1887, they are entitled to be protected in the exclusive use of the word "Vichy" as a trade name; and as a commercial name, and otherwise, and Article VIII of that treaty is set out in the following language: "The "commercial name shall be protected in all the "countries of the Union, without obligation of "edopist, whether it forms part, or not, of a trade, "or commercial, mark," (page 24). This treaty is known as the Industrial Property Treaty, *See* Compilation of Treaties in force (edition 1899), page 684.

Article two of that treaty is in the following language: "The subjects, or citizens, of each of the "contracting States shall enjoy, in all the other "States of the Union, so far as concerns patents "for inventions, trade, or commercial, marks, and "the commercial name, the advantages that the "respective laws thereof at present accord, or shall "afterwards accord to subjects or citizens. In con-"sequence they shall have the same protection as "these latter, and the same legal recourse against "all infringements of their rights, under reserve "of complying with the formalities and conditions "imposed upon subjects or citizens by the domestic "legislation of each State." Whatever rights, therefore, might be argued for the Republic of France, as a sovereign State, under the maxim *nullum tempus occurit regi,* had there been no convention on the subject, it stands that, under this

treaty, one of two things is true: either the French Republic has no standing in Court whatever, because it does not come strictly within the terms "subjects or citizens" of the contracting States, or, if it shall be held to come within the spirit of the treaty, and of this language: "The subjects or "citizens of each of the contracting States shall "enjoy, &c.," then it comes into our Courts as the treaty provides, and with no other, or greatr, rights than a subject or citizen of the country, or of any of the countries represented in the convention where this treaty of 1883 was adopted, and, such being the case, it cannot be heard to say that laches is not imputable to it, precisely as to a private person. In other words, concede all that is claimed by the appellants, and that laches cannot be imputed to a sovereign power, even to a foreign one coming into our courts in the absence of any convention on the subject, it yet was competent for the French Republic, or any other sovereign ,to waive any such prerogative possessed by it, and to agree that, in coming into our courts, it should possess only the same rights, and be governed by the same rules, that subjects and citizens of each of the contracting parties could enjoy, and this was certainly done in the most unmistakeable language; and it must be assumed that for thus surrendering a privilege it would, perhaps, otherwise have had, it received some compensatory benefit, in some other clause of the Treaty.

Moreover, no rights can be held to accrue to the complainants under the eighth article of this treaty for the reason that when

it was proclaimed by the President, in 1887, and became effective, the defendant had then already been using the name "Vichy" for fourteen years; and the terms of the treaty could have no retroactive effect upon the rights of the defendant. The defendant was already the owner of valuable rights in the word Vichy and no treaty, nor proclamation thereof, could take them away, and any attempt to do so would find itself in direct conflict with the provisions of the Constitution.

3" But the French Republic has no interest in the controversy here, is not a proper party to the record, and her presence on the record, without interest and without right, cannot be heard to save the case, in which only the appellant company has any interest, from the result of the laches existing here.

The allegation of the bill is that in the year 1853 the predecessor of the French and in the month of June in that year, in consideration of a stated rental, or tribute, duly leased to a co-partnership, the predecessor in title of the complainant Company, the exclusive right and privilege of operating these springs at Vichy, and all the rights and privileges thereunto belonging, including the exclusive right and privilege of taking the waters from the springs and the preparation and sale thereof in bottles, for the term of thirty-three years from June 10, 1853, (*See* 11th

paragraph of the Bill, pages 3 and 4). In the twelfth and thirteenth paragraphs, page 4, it is alleged that this lease has come to the appellant Company as owner, and that it has been extended so that it will continue under existing conditions until the year 1934.

We have then this state of facts: an owner has leased his premises to a tenant for a fixed sum, a sum which is not affected by the success or failure of the business of the tenant. During the existence of this lease, certain things have occurred which, it is alleged, have done harm to the business of bottling and selling the water taken from such leased premises, by imitating a trade-mark owned exclusively by the lessee. There is no allegation, as there is no proof, that the acts complained of do any harm to the realty, directly or indirectly, or that it will be less valuable than it otherwise would have been, when it shall again revert to the owner, at the expiration of the lease. And, on this state of facts, this Court is asked to hold that the lessor, the owner, is a necessary party to an action brought for an injury done solely to the business and property of the tenant; and, having held that it is such necessary party, it further asked to hold that its presence — it being a sovereign power — will save the case from the condemnation that otherwise would be visited upon it, because of unmistakeable, and undisputed, laches. The Republic has adopted no trade-mark, has acquired no trade name, or commercial name, is an entire stranger in law to the business carried on by the Company, and can neither be benefitted by its success, nor damnified by its failure. Under such circumstances it is sub-

mitted that no possible reason exists in either allegation or proof, for making, or keeping, the Republic a party.

The rule is illustrated by the case of Kernochan v. N. Y. Elevated R. R. Co., 128 N. Y., 559, 566, 568. That was an action brought by the plaintiff for damages sustained by reason of the construction of the elevated railway, and the question for decision, as stated by Judge Andrews (page 562), was, whether the owner of premises in the City of New York, who, after the construction of the elevated railroad in the street upon which the premises abutted, leased them for a term of years, could maintain an action for damages for the impairment of easements in the street appurtenant to his premises, by the existence and maintenance of the road, suffered during the period in which the premises were in the actual occupation of tenants under the lease, or whether the right of action is in the lessee. It was held that under such circumstances the lessor could recover, upon the thoroughly sound reasoning that the lease having been made after the damages had accrued, it was patent that the reserved rental was fixed with the damage in mind, but that (page 568) "in "a case where the lease was made prior to the con- "struction of the road different consideration "would apply. Under such a lease the lessee is "the party who would be entitled to maintain an "action, for the same reason that we hold the lessor "is entitled in the present case, viz: that he suffers "the injury."

The learned counsel for the complainants seeks to distinguish the case cited from the one at bar,

but the analogy between the two is complete. The Republic here is the owner of the fee of the realty upon which the springs are situated, precisely as was Kernochan in the case cited. The Company here is the lessee of the realty, precisely as there was a lessee in the case cited, and it is the lessee alone who, the Court held, was entitled to recover for damages accruing after the lease was given.

It may be urged that in the Kernochan case, the damage was to real estate, and so the cases are different; but real estate is all that the Republic owns here. It owns neither bottles, trade-mark, trade name, nor business, nor has any interest therein.

Conceding now everything said by the complainants here as to the damage done by the defendant to the bottling and sale of water which comes from the land owned by the French Republic, and leased by the complainant Company, as such damage was claimed to exist in the year 1898, when the bill was filed, or in this year 1903, when this appeal is being argued, what reason is there to believe that when the leased premises shall revert to the French Republic at the expiration of the lease, they will be any less valuable, by reason of anything done by the defendant here, than they would have been had the defendant never discovered its spring? If there is any possible effect that could be imagined, the court certainly will not indulge in speculation on the subject, in default of allegation in the bill, and proofs in the case. The complainants have tendered no such issue, and the defendant has offered no evidence on the subject, and the court

cannot, in the absence of both allegation and proof, pass on the question.

The complainant the French Republic thus having no interest in the subject matter of the suit, the action is not saved from all the results that follow from the inexcusable laches shown here. Even if the Republic of France were correctly on the record as a nominal party, for the benefit of the complainant company, and to enable it to vindicate its rights, such presence on the record, in nominal capacity, would not save any rights to the complainant company, that it would not have had in its own name, as the controversy would be regarded, in such case, as it really would be, between the private litigants, and where such is the case, the rules in controversies between private individuals, will be applied.

State of Maryland v. Baldwin, 112 U. S., 490-1.

U. S. v. Beebe, 127 U. S., 338-346-7.

Justice Lamar, in writing for the Court in the case last cited, says: "The mere use of its (United States) name, in a suit for the benefit of a private "suitor, cannot extend its immunity as a sovereign "government to such private suitor, whereby he "can avoid and escape the scrutiny of a court of "equity, into the matters pleaded against him by 'the other party; nor stop the court from examining "into, and deciding, the case according to the prin- "ciples governing courts of equity, in like cases "between private litigants."

The action, from the opinion in which quotation is made, was brought by the United States to cancel

certain land patents that had been given to one Beebe, on the ground that, when the patents were issued, the lands were owned by other persons. Because the action was really for the benefit of the owners of the land, although brought in the name of the United States, the bill was dismissed for laches.

The appellants seek to answer this position, and to save their joinder of the Republic by citing a large number of cases (page 40, appellants' brief), holding that it is proper to unite the patentee and licensee, in an action to restrain an infringement of a patent.

There is no analogy between the cases. A patentee granting a license, even an exclusive one, does not divest himself of the title to the patent, the thing injured, and has his direct interest to see that for an injury to his property, he is recompensed in damages, or protected by injunction.

In the case of Waterman v. Mackenzie, 138 U. S., 252-255, Justice Gray clearly sets out the distinction between cases where a patentee must be joined, and those where he cannot. "The patentee, or is "his assigns, may, by instrument in writing, assign, "grant and convey, either, 1" the whole patent, "comprising the exclusive right to make, use and "vend the invention, throughout the United "States; or 2" an undivided part or share of that "exclusive right; or 3" the exclusive right under "the patent within and throughout a specified part "of the United States, Rev. Stat. Sec. 4898. A "transfer of either of these three kinds of interests "is an assignment, properly speaking, and vests "in the assignee a title in so much of the patent

"itself, with a right to sue infringers; in the sec-
"ond case, jointly with the assignor; in the first
"and third cases, in the name of the assignee alone.
"Any assignment or transfer, short of one of these,
"is a mere license, giving the licensee, no title in
"the patent, and no right to sue at law, in his own
"name for an infringement."

The language of the learned justice is simply equivalent to saying that the party having the interest to be protected must maintain the action. If an assignee has obtained the whole title, he must bring suit; if the patentee and assignee have a joint interest, both must sue; if there is outstanding a mere license from the patentee, the patentee, the owner, must vindicate right.

Not only is there, in all this, no warrant for joining as complainant, a lessor, who owns only real estate, which is not injured by the acts complained of, and which is not claimed to be injured, and who has no title nor interest in the property that is injured, the trade-mark or trade name, but it expressly shows that such joinder cannot be had.

If the lease of the Republic to the complainant company, reserved as rental, a percentage of the profits made by the company, a joinder might be proper, but that is not the case. The rental is a fixed sum — as alleged in the eleventh paragraph of the bill, a stated rental, or tribute, (page 3).

If this reasoning is correct it follows, not only that the presence of the Republic, as a complainant on the record cannot save the application of the rule as to laches, but it has no interest in the controversy, and should have been dismissed.

## V

The name Vichy is a geographical name, as is alleged in the bill, and as is shown by the proof, and as such geographical name the complainants have no right to insist on its exclusive use as a trade-name.

Canal Co. v. Clarke, 13 Wallace, 311, 324.
Columbia Mill Co. v. Alcorn, 150 U. S., 460-3 *et seq.*

The case last cited treats the subject exhaustively and in his opinion Judge Jackson cites the case of Koehler v. Sanders, 122 N. Y., 65, which held that the word "International" could not be used as a trade name; Connell v. Reed, 128 Mass., 477, that "East Indian" could not be so used; Glendon v. Uhler, 75 Pa. St., 467, holding that where one company had adopted the word Glendon, after which a borough was created by the name of Glendon, and a second company then stamped its product as Glendon, that it had a right to do so; Amoskeag Mfg. Co. v. Spier, 2 Sandf., 599, which holds that no one has a right to appropriate a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth.

*See* too Barrett Chemical Co. v. Stern, 176 N. Y., 27-30.
Levy v. Waitt, 61 Fed. Rep., 1008.
Ill. Watch Co. v. Elgin Watch Co., 94 Fed. Rep., 667.
Hoyt v. Lovett, 71 Fed. Rep., 173.
Republic v. Schultz, 94 Fed. Rep., 500.
Luyntes v. Hollander, 30 Fed. Rep., 623.

# VI

The complainant company, on the 7th of August, 1877, registered its trade-mark in the patent office (p. 407). In the statement filed it is claimed that the trade-mark consists of an oval medallion, within which a perspective view of the buildings of the Thermal establishment of Vichy is represented, and also a scroll, or band, above the buildings bearing the words, "Establissement Thermal de Vichy, Ouvert Toute l'Annee."

The essential feature of the trade-mark was said to be the oval medallion with the representation of the Thermal buildings.

It will be observed from this statement of claim that the word Vichy is not at all accentuated, nor, indeed, mentioned, except incidentally, and it is manifest from an examination of the filed, as well as from the claim, that in the mind of the complainant company the medallion was everything and the word Vichy nothing. In thus registering what it claimed as its trade-mark, it essentially disclaimed any exclusive right to the use of the word Vichy.

The case of Richter v. Anchor Remedy Company, 52 Fed. Rep., 455, is directly in point: "The "opinion says, (p. 458): "But furthermore, "certainly a trade-mark may be abandoned, "and what clearer evidence of abandonment "of the right to the unlimited use of the "anchor emblem could there be, than was "furnished by the plaintiff's restricted registration "on July 17th, 1885. He thereby gave public notice "to all traders, and others in the United States,

"that he adopted as his trade-mark for medical "compounds, not the representation of an anchor "generally, but a red anchor in the (white) oval, "space or field. This limited registration was the "very deliberate act of the plaintiff, and he must "abide by the consequences."

This case was affirmed in Richter v. Reynolds, 59 Fed. Rep., 577.

In the case of Pittsburgh Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep., 637-8, the District Court of the Eastern District of Missouri, in 1898, says that by a failure to claim a letter in its specification of a trade mark, a party must be held to have abandoned such feature of its mark to the public, if it ever employed it, and, thereby, to have disclaimed any exclusive right to it. Citing the Richter case, *supra*.

Browne on Trade-Marks, 2" Ed., Sec. 678, lays down the principle that when a word, coined by a manufacturer to indicate a peculiar product, is disused by him, and other persons in the same line of business, by common consent, adopt the word as the most suitable name for the thing, then such name falls into the domain of commerce and is not susceptible of reappropriation by the manufacturer who first used it as a fanciful denomination for his manufacture.

# VII

Finally, the case of Saxlehner v. Eisner, 179 U. S., 19, decided by this court in the year 1900, must be regarded as controlling on the main points raised in this case. The opinion in that case was written by Mr. Justice Brown, and distinctly recognizes, and affirms.

1" That a trade-mark cannot be, either descriptive, or geographical (p. 30), and that, therefore, the name Hunyadi, was the proper subject of a trade-mark.

Here the name Vichy is, beyond challenge, geographical, and, therefore, is not a proper subject for a trade-mark.

2" That the word Hunyadi had become, in a sense, generic, indicating an Hungarian bitter water; and, if it thus became generic with the assent, and acquiescence of Saxlehner, he could not, ~~therefore, assert his right to its exclusive use, but~~ thereafter, assert his right to its exclusive use, but that he had never so assented, (p. 33).

Here, the word Vichy has become generic, and, not only with the acquiescence of the complainants for more than a quarter century, but, further, the complainant company made no claim to it in its statement accompanying, and forming part of the registry of its trade-mark.

3" That the competing waters having come into the United States as early as 1886, Saxlehner was guilty of laches in not having sooner sought vindication of his rights, and this, nothwithstanding, some not entirely unreasonable excuses were

offered, for not proceeding earlier with his suit, (p. 35).

4" That by a use of twenty years in Hungary, by other dealers, of the word Hunyadi, it became public property there, and, therefore, here; and that, although by a subsequent change of the Hungarian law, Saxlehner became entitled to its sole use, it worked no such result here (p. 36), and that by inaction for twenty years, the complainant had placed herself outside the requirements of our courts, in such cases, (p. 37).

The delay here is some five years greater than in the Saxlehner case, and there has been no fraud on the part of the defendant.

The Saxlehner case must be regarded as a decisive authority here, and the decree of the court below should be affirmed.

Saratoga Springs, N. Y., October 31", 1903.

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